

### REMARKS

These remarks are in response to the Office Action dated October 3, 2008, which has a shortened statutory period for response set to expire January 3, 2009. A two-month extension, to expire March 3, 2009, is requested in a petition filed herewith.

#### Claims

Claims 1-108 are pending in the above-identified application. Claims 1-108 are rejected over prior art. Claims 1, 43, 50, 53, 57, 62-81, 101-102 and 107 are amended, and Claims 109-122 are added. Claims 2-42, 44-49, 51-52, 54-56, 58-61, 82-100, and 103-106, and 108 remain as filed. Reconsideration is requested.

#### Claim Objections

Claims 62-80 are objected to under 37 CFR §1.75(c), as being of improper dependent form for failing to further limit the subject matter of the previous claim. Claim 62 is amended herein to be in independent form, and Claims 63-80 are amended to depend, either directly or indirectly, from Claim 62. Therefore, Claims 62-80 are now in proper dependent form, and Applicants respectfully request the withdrawal of the objection to Claims 62-80.

#### Rejections Under 35 U.S.C. § 112

Claims 45-48 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner writes:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 45-48 recite “a method according to Claim 1, further comprising ***receiving media file identifiers associated with media files that should no longer be presented***; further comprising ***receiving media file identifiers associated with media files that are not to be transferred***; further comprising ***receiving media file identifiers associated with media files that are to be removed from said user’s system***; further comprising ***receiving a new media file identifier associated with a new media file that should be substituted for an existing media file***. (emphasis original)

The specification teaches that the program identifies a media content item on the basis of a unique universal identifier

stored in any number of locations, including, but not limited to, local database 562 and/or the media file itself. The specification further teaches that the program then uses the identifier to locate the item by first going to local database 562, and if not found, to media catalog 566. The specification however does not teach how the identifier is transmitted or transferred and presented. Therefore, the claims are rejected as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully traverse.

Initially, Applicants note that Claims 45-48 are original claims that were filed with the original application and, therefore, form a part of the original specification. The Examiner's sole concern appears to be that the specification does not teach "how the identifier is transmitted or transferred and presented."

The Examiner appears to recognize that the identifiers are used to control presentation, transfer, removal, etc. of the media files. In addition, Applicants' specification provides:

The player/viewer software may employ a **distributor-controlled** licensing database, allowing the system to track a variety of service types by which a particular user could license a particular media property. Such a database also **gives the distributor complete control** over the system, providing the player/viewer the ability to grant or deny service altogether, depending on the property and/or the user. In this way, the present invention **endows the distributor with the complete power** to limit consumer use as directed by the copyright holder, on a property by property basis, and to adjust the amount of required advertising as needed. (Page 11, Lines 14-20, emphasis added)

...

If user-contributed content is distributed through the system, then later found to be equivalent to a copyright-holder provided title, **the distributor can provide for the automatic replacement of such secondary content with the version approved for distribution**. This process is known as "media rotation". Similarly, if a copyright-holder identifies invalid content and does not wish to have it further distributed, the content may be either banned for redistribution or recalled entirely, having all existing copies removed from the system. (Page 23, Line 26 – Page 24, Line 2, emphasis added)

These example excerpts of Applicants' original specification make it clear that it is the distributor that controls the presentation, transfer, removal, and/or substitution of media files on a

user's system. Thus, one skilled in the art will immediately recognize that the instructions for such media control, along with the identifiers (which the Examiner recognizes are used to implement such control) would be transmitted to the user's system by the distributor. The system for communicating the instructions and identifiers is also shown in Fig. 1.

In view of the foregoing excerpts from Applicants' original specification, Applicants respectfully assert that one skilled in the art would not require "undue experimentation" to determine how to transfer an instruction and an identifier from distributor 120 to a user system 104 to control presentation, transfer, removal, and or substitution of a media file.

For the above reasons Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112.

#### Rejection Under 35 U.S.C. §101

Claims 1-61 and 104-108 are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Regarding Claims 1-61, as indicated above in the Interview Summary, the Examiner agrees that the present amendment of Claim 1 overcomes the rejection under 35 U.S.C. §101. Claims 2-61 depend, either directly or indirectly, from Claim 1 and, therefore, also satisfy the requirements of 35 U.S.C. §101.

Applicants respectfully traverse the rejection of Claims 104-106, because original Claim 104 recites statutory subject matter. In particular, Claim 108 recites (in part) "providing media files containing copyrighted works" and "providing a media player operative to ... present the content of said media files with the content of said ad files." Copyrighted works are necessarily fixed in a tangible medium. In addition, the media player is a physical object (whether software, hardware, firmware, or some combination thereof) that presents the content of the media files to a user. Moreover, the media player necessarily physically transforms the media files and ad files to a format that can be perceived by a user. For at least these reasons, Claim 104 recites statutory subject matter.

Applicants also respectfully traverse the 35 U.S.C. §101 rejection of Claims 107-108. Claim 107 is a data structure claim that specifically recites "[a]n electronically readable medium." These data structure claims are commonly referred to as Lowry claims, after the Federal Circuit Decision In re Lowry 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed Cir. 1994). MPEP

§2106.01 provides: “When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” (citing *In re Lowry*) For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 107-108 under 35 U.S.C. §101.

#### Rejections Under 35 U.S.C. § 102

Claims 1-108 are rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 6,950,804 (Strietzel).

#### Claims 1-61

As indicated above in the Examiner interview, agreement was reached that the amendment to Claim 1 distinguishes over Strietzel. For example, Claim 1 recites (in part) “sequencing said stored media file content and said stored ad file content in said media player” In contrast, according to Strietzel, ads are embedded in a media file in a server and then transmitted to a user as one contiguous file. Because the cited reference does not disclose this aspect of Claim 1, it does not anticipate Claim 1. Claims 2-61 depend, either directly or indirectly, from Claim 1 and are, therefore, distinguishable over the cited reference for at least the same reason.

#### Claims 62-80

As amended herein, Claim 62 now recites (in part) “sequencing said stored media file content and said stored ad file content in said media player.” Therefore, Claim 62 is distinguished over Strietzel for at least the reasons set forth above with respect to Claim 1. In particular, Strietzel does not disclose that the media file content and the ad file content are sequenced in the media player. Claims 63-80 depend, either directly or indirectly, from Claim 62 and are, therefore, distinguished from the cited reference for at least the same reasons as Claim 62.

Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 62-80 in view of the amendment of Claim 62.

Claims 81-101

As amended herein, Claim 81 now recites (in part) “said user interface, said ad manager, and said intersplicer being disposed locally with respect to said media player.” Therefore, Claim 81 is distinguished over Strietzel for at least the reasons set forth above with respect to Claim 1. Claims 82-101 depend, either directly or indirectly, from Claim 81 and are, therefore, distinguishable over Strietzel for at least the same reasons as Claim 81.

Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 81-101 in view of the amendment of Claim 81.

Claims 102-103

As amended herein, Claim 102 recites (in part) “means for sequencing said presentation media and said ads for presentation by said media player, said means for sequencing being co-located with said media player.” Therefore, Claim 102 is distinguished over Strietzel for at least the reasons set forth above with respect to Claim 1. Claim 103 depends from Claim 102 and is distinguished over the cited reference for at least the same reasons.

Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 102-103 in view of the amendment of Claim 102.

Claims 104-106

Applicants respectfully traverse the rejection of Claims 104-106 over Strietzel, because Strietzel does not disclose “providing a media player operative to combine and present the content of said media files with the content of said ad files,” as recited in original Claim 104. Rather, as indicated above, Strietzel discloses a server that appends advertisements to content items that are then delivered to the user via a communication link. See e.g., Col. 3, Lines 11-18. The combination of the advertisement and the content item occurs at the server, not at the user’s media player. For at least these reasons, Strietzel does not anticipate Claim 104. Claims 105 and 106 depend from Claim 104 and are distinguishable over the cited reference for at least the same reasons as Claim 104.

Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 104-106.

Claims 107-108

Claim 107 is amended herein to combine the claimed data structure with “code for causing an electronic device to present said media file to a user.” Strietzel does not anticipate amended Claim 107, because Strietzel does not disclose the claimed data structure in combination with “code for causing an electronic device to present said media file to a user,” as recited in Claim 107. Indeed, there would be no reason for doing so in Strietzel, because the ads are appended to the content at the server end of the communication link, not at the media player. Claim 108 depends from Claim 107 and is, therefore, distinguished from the cited reference for at least the same reasons.

Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 107 and 108 in view of the amendment of Claim 107.

For the above reasons Applicants request reconsideration and withdrawal of all rejections under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

Claims 86-88 are rejected under 35 U.S.C. § 103 as being unpatentable over Strietzel in view of Eyer et al. (U.S. Patent No. 6,588,015).

Applicants respectfully assert that the amendment of Claim 81, from which Claims 86-88 depend, renders the rejections under 35 U.S.C. §103 moot. Therefore, Applicants request withdrawal of the current rejections under 35 U.S.C. §103.

New Claims 109-122

Support for new Claims 109-110 is provided in Applicants’ original specification at least at Page 43, Lines 1-20.

Support for new Claim 111 is provided in Applicants’ original specification at least at Page 61, Lines 4-8.

Support for new Claim 112 is provided in Applicants’ original specification at least at Page 27, Lines 24-31.

Support for new Claim 113 is provided in Applicants’ original specification at least at Page 39, Lines 15-21 and Page 40, Lines 7-27.

Support for new Claim 114 is provided in Applicants' original specification at least at Page 61, Lines 4-8.

Support for new Claims 115-116 is provided in Applicants' original specification at least at original Claim 57.

Support for new Claims 117-118 is provided in Applicants' original specification at least at original Claims 51-52.

Support for new Claims 119-120 is provided in Applicants' original specification at least at Page 39, Lines 22-28.

Support for new Claims 121-122 is provided in Applicants' original specification at least at Page 39, Lines 15-28 and Page 40, Lines 7-27.

Each of new Claims 109-120 depends, either directly or indirectly, from an independent base claim that is allowable over the prior art of record for at least the reasons provided above in response to the respective prior art rejections.

For the foregoing reasons, Applicants believe Claims 1-122 are now in condition for allowance. Should the Examiner undertake any action other than allowance of Claims 1-122, or if the Examiner has any questions or suggestions for expediting the prosecution of this application, the Examiner is requested to contact Applicants' attorney at (269) 279-8820.

February 27, 2009

Date: \_\_\_\_\_

Respectfully submitted,

/Larry E. Henneman, Jr./

\_\_\_\_\_  
Larry E. Henneman, Jr., Reg. No. 41,063  
Attorney for Applicant(s)  
Henneman & Associates, PLC  
714 W. Michigan Ave.  
Three Rivers, MI 49093

**CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being electronically filed or transmitted via facsimile, on the date shown below, to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at (571) 273-8300.

Date: February 27, 2009

\_\_\_\_\_  
/Larry E. Henneman, Jr./  
Larry E. Henneman, Jr.